



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,690		Roger Biel	CL/V-30785A	5765

1095 7590 01/15/2003

THOMAS HOXIE
NOVARTIS, PATENT AND TRADEMARK DEPARTMENT
ONE HEALTH PLAZA 430/2
EAST HANOVER, NJ 07936-1080

EXAMINER

PUNNOOSE, ROY M

ART UNIT PAPER NUMBER

2877

DATE MAILED: 01/15/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,690

Applicant(s)

BIEL ET AL.

Examiner

Roy M. Punnoose

Art Unit

2877

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Specification

Arrangement of the Specification

1. As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading.

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (d) BRIEF SUMMARY OF THE INVENTION.
- (e) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (f) DETAILED DESCRIPTION OF THE INVENTION.
- (g) CLAIM OR CLAIMS (commencing on a separate sheet).
- (h) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

Several section headings are missing in the specification. Appropriate correction is required.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "3" has been used to designate both the 'contact lens' and its 'image' on the monitor. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Art Unit: 2877

Claim Objections

3. Claim 1 is objected to because of the following informalities: In claim 1, line 2, use of "received" is grammatically incorrect. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1, 3 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Yanagi (US 6,118,528).

- a. Yanagi discloses an ophthalmic lenses checking apparatus comprising:
- b. A container 11 to receive a lens 13 to be examined;
- c. An illuminating device 1 with at least one light source which emits a beam of light;
- d. A condenser 10 to illuminate the lens 13; and,
- e. An image-receiving device 3 to receive the image of the lens 13, whereby a light emitting diode (LED) is provided as light source, and, said ophthalmic lenses are contact lenses (see col.5, lines 1-49).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 4, 5-7 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagi (US 6,118,528).

Claims 2, 4, 5, and 13 are rejected because, in view of Yanagi's teaching of use of light source in the visible (400 nm – 700 nm typically) wavelength range (see col.5, lines 7-12), it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the visible wavelength range LEDs of Yanagi's apparatus with LEDs of any other wavelength range including infrared (IR) LEDs, due to the fact that such substitution would provide an alternate wavelength range for inspecting ophthalmic lenses. Accordingly, such substitution of light sources would have constituted an alternative means/obvious engineering expedience for one of ordinary skill in the art at the time the invention was made.

Claims 6 and 14-17 are rejected because, in view of Yanagi's teaching of use of light filters (see col.7, lines 52+) to filter out undesired light and pass only light in the desired wavelength range to the light receiving means/CCD 3 (Figure 1), it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a light filter in front of the light receiving means/CCD in Yanagi's apparatus due to the fact that placing such a filter in front of the light receiving means/CCD would provide an alternate way to pass only light in the desired wavelength range to the light receiving means/CCD in the inspection ophthalmic lenses.

Accordingly, such choice of location for the filter would have constituted an alternative means/obvious engineering expedience for one of ordinary skill in the art at the time the invention was made.

Claim 7 is rejected because, in view of Yanagi's teaching of the use of a CCD as a light receiving means in the inspection ophthalmic lenses, it would have been obvious to one of ordinary skill in the art at the time the invention was made to claim that said CCD is a high resolution CCD selected for providing a clear and sharp image on the monitor for more accurately inspecting the ophthalmic lenses. Accordingly, such selection of a high resolution CCD would have constituted an alternative means/obvious engineering expedience for one of ordinary skill in the art at the time the invention was made.

8. Claims 8-10 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagi (US 6,118,528) in view of Ebel et al (5,812,254).

A). With regard to claims 8, 9 and 18-20 Yanagi teaches all claim limitations as above except for the teaching of moving the CCD camera by means of x-y or x-y-z moving mechanism in an apparatus used for inspecting ophthalmic lenses.

B). Ebel et al (Ebel hereinafter) discloses an apparatus comprising a CCD camera that is attached to a x-y-z moving mechanism (see col.4, lines19-25; Figure 1), said apparatus used for inspecting ophthalmic lenses.

C). In view of Ebel's teaching of a CCD camera that is attached to a x-y-z moving mechanism, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a x-y-z moving mechanism into Yanagi's apparatus due to the

Art Unit: 2877

fact that such a moving mechanism would provide a way to easily adjust the CCD cameras at a desired location in an apparatus used for inspecting ophthalmic lenses. Accordingly, such incorporation would have constituted an alternative means/obvious engineering expedience for one of ordinary skill in the art at the time the invention was made.

With regard to the use of stepping motor units for moving the CCD camera in claim 10, it is commonly and widely known in the art that stepping motors are used in such x-y-z mechanisms in image acquisition systems. Therefore incorporating stepping motor units in said ophthalmic inspection apparatus would have constituted an alternative means/obvious engineering expedience for one of ordinary skill in the art at the time the invention was made.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagi (US 6,118,528) in view of Ebel et al (5,812,254) and further in view of Davis (5,828,446).

A). Yanagi and Ebel discloses all claim limitations as disclosed above except for the explicit teaching that the CCD is linked to a computer and a software-supported image analysis system is used for inspecting the ophthalmic lenses.

B). Davis discloses an apparatus comprising a CCD 126 (see Figure 7) linked to a computer system (see Figure 1) that has software-supported image analysis system for inspecting ophthalmic lenses (see col.4. lines 47-56).

C). In view of Davis' teaching as disclosed above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a CCD linked to a computer system that has software-supported image analysis system into Yanagi's apparatus due to the fact that such a system would provide a more efficient apparatus/system for inspecting

Art Unit: 2877

ophthalmic lenses. Accordingly, such incorporation would have constituted an alternative means/obvious engineering expedience for one of ordinary skill in the art at the time the invention was made.

Conclusion

10. The prior art Epstein et al (US 6,301,005 B1) is made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner Roy M. Punnoose** whose telephone number is **703-306-9145**. The examiner can normally be reached on 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the applicant can reach his **Supervisory Patent Examiner, Frank G. Font**, at (703) 308-4881.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-0530.

Roy M. Punnoose
Patent Examiner
Art Unit 2877
January 3, 2003

 **Mr. Frank G. Font**
Supervisory Patent Examiner


Michael P. Stafira
Primary Patent Examiner
Technology Center 2800